

### **REMARKS**

The Final Office Action dated August 30, 2006 has been reviewed carefully and the application amended in a sincere effort to place the remaining amended claims in condition for allowance. Reconsideration of the rejection of the remaining claims, which have been amended directly or indirectly, and allowance of the same, are respectfully requested on the basis of the following remarks.

Upon entry of this response, claims 29-33, 35-41, and 43-44 will be pending in this application. Claims 1-28, 34, and 42 have been canceled.

Claims 29 and 37 have been amended to recite that the mobile data device gives preference to various ones of the plurality of system preference criteria to create a ranking of available networks.

### **The Present Application**

In general, the present application relates to a system and method wherein a mobile data device is provided with a preferred roaming list that includes information indicating whether each network in the list (e.g. a 3G network) supports 3G data capabilities (as opposed to, for example, 3G voice capabilities). This is advantageous because not all 3G networks are capable of supporting data services and by including information regarding the 3G data capabilities of the network in the preferred roaming list the battery life of the mobile data device is prolonged or preserved since the mobile data device will not attempt to access a 3G network lacking 3G data capabilities when 3G data capabilities are needed.

**Rejection of Claims 1-10, 11-19, 20, 29-36, and 37-44 under 35 U.S.C. 112**

The Examiner has rejected these claims for failing to comply with the enablement requirement.

Claims 1-28 have been canceled. Therefore, the rejection of these claims is now moot.

Claims 29 and 37 have been amended with the limitations that were recited in claims 34 and 42, respectively. Moreover, the feature that recites "...said choosing step overriding network preferences in said preferred roaming lists..." which was previously added to claims 29 and 37, and which the Examiner contends has no support in the specification, has been deleted. Because there is support for the features recited in amended claims 29 and 37, Applicants' respectfully submits that amended claims 29 and 37, and the claims that depend therefrom, comply with 35 U.S.C. 112. The Applicants, therefore, request that the rejection of these claims under 35 U.S.C. 112 be withdrawn.

**Rejection of Claims 1-10, 11-19, 20, and 21-26 under 35 U.S.C. 103(a)**

The Examiner has rejected these claims as being unpatentable over Bridges (WO 99/45723) in view of Guilford (U.S. 2002/0087674).

As stated elsewhere herein, claims 1-28 have been canceled. Accordingly, the rejection of these claims is now moot.

**Rejection of Claims 29-44 under 35 U.S.C. 103(a)**

The Examiner has rejected claims 29-33, 35, 37-41, and 43-44 as being unpatentable over Islam (2005/0090277) in view of Guilford. Additionally, the Examiner has rejected claims 34 and 42 as being unpatentable over Islam in view of Guilford and further in view of Almgren. The Examiner has also rejected claims 36

as being unpatentable over Islam in view of Guilford and in further view of Russell (US 2004/0249915).

Claims 29 and 37 have been amended with the feature originally recited in claims 34 and 42, respectively. Specifically, claims 29 and 37 have been amended to recite that the mobile data device gives preference to various ones of the plurality of system preference criteria in order to create a ranking of available networks.

The Examiner has conceded that Islam and Guilford, alone or in combination, do not disclose the feature that was recited in claims 34 and 42. Accordingly, the Examiner relies on Almgren (WO 2004/066663) to disclose this feature. See page 10, paragraph 7, of the Office Action.

However, contrary to the Examiner's contention, it is submitted that there is no motivation or suggestion to combine the references as suggested by the Examiner. Moreover, it is noted that the Examiner has not provided a reason why one skilled in the art would combine the cited references.

Additionally, the Applicants respectfully disagree with the Examiner's position that Almgren's Abstract discloses a mobile device that creates a ranking of networks. In Almgren, a preferred list of networks exists which are ranked previously and stored on the mobile device. The method of Almgren is designed to move the mobile device into a more preferred network according to that ranking by changing an "elementary file" stored on the mobile device.

As indicated on page 2, line 10, there are three types of files: elementary files, dedicated files, and master files.

As indicated on page 7, line 25, the files that are subject to usage for dynamic roaming solutions would typically be  $EF_{LOC1}$  and  $EF_{FPLMN}$ . The  $EF_{LOC1}$  is used by the phone to remember the location area it is registered to.

As indicated on page 8, line 2, from the information in the EF<sub>LOC1</sub>, the phone knows which network it was on before it was turned off. When re-establishing network connection, the phone first attempts to register to the network whose identity is found in the EF<sub>LOC1</sub>.

The Almgren reference then goes on to describe various embodiments of a method to update the EF<sub>LOC1</sub> file. A first embodiment uses a roaming module found on the network to trigger the EF<sub>LOC1</sub> update. The second embodiment utilizes the HLR on the network to tell the ME that the EF<sub>LOC1</sub> should be updated. The third embodiment writes the new EF<sub>LOC1</sub> after certain roaming functions are performed.

Almgren, in other words, does not indicate that the mobile device creates a ranking of available networks. In fact, the ranking of available networks is static in a first file on the mobile device. The mobile device then uses the first file to find a more preferred network. This is not the creation of a ranking of available networks since the rankings on the mobile device of Almgren never change.

Because there is not motivation or suggestion to combine the references, and because the references, alone or in combination, do not disclose every feature that is recited in amended claims 29 and 37, Applicants submit that amended claims 29 and 37, and the claims that depend therefrom, are in condition for allowance. Accordingly, withdrawal of the rejection of these claims is respectfully requested.

### **CONCLUSION**

In light of the foregoing amendments and arguments, it is respectfully submitted that claims 29-33, 35-42, and 43-44, are in proper form for issuance of a Notice of Allowance and such action is respectfully requested at an early date.

In the event that any outstanding matters remain with this application, examiner is invited to telephone the undersigned at 412-566-1920 to discuss such matters.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert A. Diaz".

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